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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/784,401

02/23/2004

Peter M. Bonutti

780-A04-002-1

1827

33771 7590 03/18/2008  
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MIAMI, FL 33180

EXAMINER

GETTMAN, CHRISTINA DANIELLE

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

03/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,401	<b>Applicant(s)</b> BONUTTI, PETER M.	
	<b>Examiner</b> CHRISTINA D. GETTMAN	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 16-19, 24 and 26-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 16-19, 24, 26-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 5, 2007, has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 40-43 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said first tissue" in line 6. There is insufficient antecedent basis for this limitation in the claim. The Examiner believes the limitation should recite --said first tissue engaging surface--.

Claim 40 recites the limitation "said first tissue" in line 9. There is insufficient antecedent basis for this limitation in the claim. The Examiner believes the limitation should recite --said first tissue engaging surface--.

Claim 41 recites the limitation "said handle" in line 4. There is insufficient antecedent basis for this limitation in the claim. The Examiner believes the limitation should recite --said second handle--.

Claim 42 recites the limitation "said handle" in line 4. There is insufficient antecedent basis for this limitation in the claim. The Examiner believes the limitation should recite --said second handle--.

Claim 43 recites the limitation "said handle" in line 4. There is insufficient antecedent basis for this limitation in the claim. The Examiner believes the limitation should recite --said second handle--.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 19, 24, 26-29, 31, 35, 37, 40-41 rejected under 35 U.S.C. 102(b) as being anticipated by Holmes (U.S. Patent no. 5,417,701). Holmes discloses the invention as claimed including a first tissue engaging surface (ref. 18; holds a medical implement), a second tissue engaging surface (the 2<sup>nd</sup> instrument; holds a medical implement and allows for it to penetrate the tissue), a magnetizable material (the 2<sup>nd</sup> instrument has a tissue engaging surface that is magnetized), a magnetic field generator (ref. 36), the magnetic field generator being a permanent magnet (ref. 36), the medical implement being a surgical needle (ref. 32), the magnetic field generator being

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positioned external to tissue, a body (ref. 20) with a carrier (ref. 34), a tip located at the distal end of the body (needle tip; ref. 32a), a magnetic element (ref. 36) being part of and attached to the body as well as being a permanent magnet, and the magnetic element being movable (the claim does not recite what the magnetic element is movable relative to; the magnetic element is movable by the surgeon as the surgeon moves the body), and a means for (two handles) mechanically urging the surfaces towards one another (ref. 16a and 16b), a pivot connecting the handles (ref. 26).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-7, 30, 32-34, 36, 38-39, and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes ('701) in view of Holmes (U.S. Patent No. 5,431,670). Holmes ('701) disclose the invention substantially as claimed including the strength of the magnetic field varying (the two instruments can be moved closer or farther from each other to create a varying strength magnetic field), the magnetic field generator being positioned external to tissue, and the generator being positionable (by the surgeon). Holmes ('701) does not disclose the magnet being an electromagnet or a biasing member. Holmes ('670) teaches an electromagnet (ref. 18) that has a reversible polarity (col. 4, lines 46-50) for the purpose of releasing moving a needle through tissue and allowing for it to be released. Therefore, it would have been obvious to one having

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ordinary skill in the art at the time of the invention to have modified Holmes ('701) with the magnet being an electromagnet with reversible polarity, as taught by Holmes ('670), in order to move a surgical needle from one side of tissue to another and in order for it to be released from the instrument once suturing is completed. It is well-known in the art to add springs to medical instruments to bias two surfaces towards or away from each. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Holmes ('701) with a spring in order to bias the surfaces and/or handles away or towards each other. Holmes ('701) also does not disclose the use of iron as the magnet. However, iron is a well-known material that is used in the art as a magnet and, therefore, it would have been obvious to have made the magnetizable material out of iron.

### ***Response to Arguments***

Applicant's arguments filed December 5, 2007, have been fully considered but they are not persuasive. Applicant argues that Holmes ('701) does not show a first tissue conducting [sic] surface that magnetically attracts a second tissue contacting surface. Examiner respectfully disagrees.

A tissue contacting surface, as recited in the claim limitations, is no more than a surface that is capable of contacting tissue. Holmes ('701) clearly shows this as well as disclosing a second instrument that aids in the movement of the needle. The needle can also be considered a magnetizable material since it is attracted by each of the surfaces. Both instruments allow and aid for the penetration of tissue by the medical

implement. It is also noted that the claims do not recite where the surfaces are located and/or attached to one another.

Applicant's arguments with respect to claims 3-5, 30, and 39 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fukuda et al. (U.S. Patent No. 5,824,009) disclose a needle that can be magnetic (col. 6, line 10-11) that has a magnetic receiver (col. 6, line 12).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINA D. GETTMAN whose telephone number is (571)272-3128. The examiner can normally be reached on Monday-Thursday 6:45 am to 4:30 pm (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

/Christina D Gettman/  
Examiner, Art Unit 3734  
571-272-3128



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